

REMARKS

Claims 1-13 and 26 will be pending upon entry of the present amendment. Claims 7, 8, and 11 are amended, and claims 14-25 are cancelled. Claim 26 is newly submitted herewith.

Election/Restrictions

Applicant acknowledges election of group I for examination in response to a restriction requirement made during a telephone conversation between Examiner Larson and the undersigned representative, and has accordingly cancelled claims 14-25.

Objections

The Examiner has objected to headings of the specification as being underlined and/or in bold. Accordingly, the sub-headings under the heading "Background of the Invention" have been amended to remove the underlining. Applicant notes that, in accordance with the instructions provided by the Examiner, these sub-headings (f)(1) and (f)(2) are not capitalized.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claim 8 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which the applicant regards as his invention. In particular, the Examiner indicates that the limitation of claim 8 lacks proper antecedent basis. Claim 8 has been amended to correct this deficiency, and is now in condition for allowance in view of § 112.

Rejections Under 35 U.S.C. § 102(b)

Claims 1, 3, 4, and 5 were rejected under 35 U.S.C. § 102(b) as being anticipated by Brame (U.S. Patent No. 4,856,149). Claims 1, 3-8, and 10 were rejected under 35 U.S.C. § 102(b) as being anticipated by Corder, Jr. (U.S. Patent No. 4,960,280, hereafter *Corder*).

One of the disclosed embodiments of the invention will now be discussed in comparison to the applied reference. Of course, the discussion of the disclosed embodiment, and the discussion of the differences between the disclosed embodiment and the subject matter

described in the applied reference, do not define the scope or interpretation of any of the claims. Instead, such discussed differences are intended merely to help the Examiner to appreciate important claim distinctions discussed thereafter.

Figure 4 of the specification illustrates an embodiment of the invention. Referring to the description at page 6, line 13, the specification states (with emphasis added),

The first loop 136 includes one or more elastomeric members 134 affixed to an *inner surface* of the first loop 136. The elastomeric members 134 may be in the form of a synthetic or natural rubber line or thread interwoven into the fabric of the first length 137 of webbing material, such that a large portion of the synthetic rubber threads is *exposed on the inner surface* of the loop 136.

Then at page 7, line 26, the operation is described:

“The elastomeric surface 134 is brought into contact with the rigid tube 102, which serves to prevent the first loop from sliding along the rigid tube.”

It may be seen that, in order to effectively grip the tube, the elastomeric material is exposed on an inner surface of the loop.

Brame is generally directed to a leash for holding a roll of tape loosely at a user's wrist to permit feeding of the tape from the roll while held by the leash. This is clear from a review of Figure 1 and the description at, for example, column 2, lines 50-55 and column 5, lines 51-62. Although Brame discloses the use of elastic material, there is no teaching, either explicit or inherent, that the elastic material is suitable for gripping a smooth surface. Such a gripping function would tend to inhibit proper operation of the device, which relies on the roll of tape rotating easily while loosely held by the leash (see column 5, lines 44-55).

Corder is generally directed to a training device worn by golfers, and includes a chest band to be worn around the user's chest, and arm bands worn around the user's upper arms. Corder also teaches the use of elastic material (column 3, lines 3 and 4) but is silent with respect to any special gripping function.

Applicant notes that elastic material such as that referred to in Brame and Corder is commonly used in garments or other applications that may come in contact with a user's skin or clothes. Accordingly, it is generally woven such that the resilient, elastomeric portion is encased in smooth, non-elastic material such as cotton or synthetic thread. Otherwise, exposed elastomeric material would have a tendency to undesirably snag or tug the small hairs of a user's

body or fabrics against which it is positioned. Thus, the mere presence of an elastic material does not inherently provide a gripping surface such as that described with reference to the embodiment of Figure 4 of the present application.

Referring again to the present application, Figure 2 shows the strap 140 affixed to an operator's wrist. In this position the operator is able to direct the operation of the blower without directly gripping the exhaust tube, or with only light pressure. Comparing Figure 2 of the present application with Corder's Figure 2, it may be seen that Corder's golf trainer is configured to be strapped around a golfer's chest such that the arm bands 4 can be strapped around the golfer's biceps (see column 3, lines 50-62). Each arm band 4, together with a portion of the chest band A, forms a loop to capture one of the golfer's upper arms. The arm bands are positioned on the chest band so that they hang behind the arms (column 3, line 57), while the D rings are positioned near the front of the golfer's chest (column 3 line 27). A review of Corder's Figure 3 shows that the actual size of each of the arm band loops formed is much bigger than would be necessary simply to encircle the golfer's bicep, since a portion of each of the loops also encircles a portion of the golfer's chest. Thus, with respect to the present application, the size of the loop that is configured to affix to an operator's wrist is significantly smaller than the size of Corder's arm band loops.

The standard that must be met to reject a claim under § 102 is outlined in the MPEP at § 2131:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference....
The identical invention must be shown in as complete detail as is contained in the ... claim.

(Citations omitted.)

Claim 1 recites, *inter alia*, "a first loop including means for gripping a smooth cylindrical surface." Brame and Corder each fail to anticipate this limitation of claim 1. The Examiner has cited the elastic material of Brame and Corder as anticipating this element of claim 1, stating that because the references teach elastic material, they must have "elastomeric threads interwoven therein that are capable of gripping a smooth cylindrical surface." Applicant

respectfully traverses this conclusion. There is no teaching in Brame or Corder that such threads are woven in a way that permits them to function as gripping means.

Brame states that “the loops of the tape leash can be constructed of elastic material, if desired” (column 6, lines 7-9). This is the extent of Brame’s disclosure regarding elastic material. There is no express statement regarding gripping means. Accordingly, in order to sustain a rejection under 35 U.S.C. § 102, the gripping means must be inherent. As has been explained above, elastic material is commonly manufactured in a form that allows it to slide across skin or other fabric, or, for that matter, across smooth surfaces. Thus, the mere reciting of elastic material is not sufficient to anticipate the gripping means of claim 1 as being inherent. If the Examiner continues to hold the position that the gripping means is inherent (i.e., by taking Official Notice), applicant respectfully requests that the Examiner provide documentary evidence showing that all elastic material includes gripping means as recited in claim 1 (see MPEP 2144.03 C). In the absence of such a showing, Brame cannot anticipate all the limitations of claim 1.

Corder states that “the golf swing trainer is ideally constructed from elastic material ...” (see column 3, lines 3 and 4). Corder’s motivation for using this material is to allow some give in the golfer’s swing, to improve the comfort of the device, and to prevent injuries (see column 2, lines 20-25 and 55-59). Corder, like Brame, is silent with respect to gripping means. Such means are clearly neither express nor inherent in Corder’s device.

For at least the reasons outlined above, claim 1 is allowable over Brame and Corder. Accordingly, dependent claims 2-6 are also allowable.

In particular, claim 4 is allowable for many of the reasons outlined with respect to claim 1. Although claim 4 recites a plurality of elastomeric threads woven into the webbing strap of the first loop, this claim is not anticipated simply by a showing of an elastic material strap having elastomeric threads, since such threads may be encased in non-gripping material to prevent undesirable gripping. Thus, the anticipating reference must be shown to include gripping means as recited in claim 1.

Amended claim 7 recites, in part, “a second strap having a first end attached to the first strap at a point in a middle region of the first strap, and a second end configured to pass through a second side of the buckle and couple to itself to form a second loop, the second loop

sized to be affixable to a user's wrist." As explained above, Corder's device provides loops that are significantly longer than those required to affix to a user's wrist. Based upon a review of Corder's figures, it appears likely that even the portion of Corder's arm band loop that is formed by the chest band strap would be longer than required to fully encircle the average individual's wrist. Accordingly, not only are Corder's arm bands not designed to affix to a wrist, they are too big to do so, since in shortening the arm band loop to a size appropriate to affix to a wrist, the D ring would be prevented by the attachment at 7 from being sufficiently reduced in size to affix to a wrist. Thus Corder does not anticipate the limitations of claim 7, which is therefore allowable, together with dependent claims 8-13 and 26.

Claim 8 is allowable in its own right for reasons similar to those put forth in support of the allowability of claims 1 and 4. In particular, Corder fails to disclose a gripping surface as recited in claim 8.

Rejections Under 35 U.S.C. § 103

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Brame in view of Olsen (U.S. Patent No. 4,422,455); claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Brame in view of Murphey et al. (U.S. Patent Application No. 2004/0084489 hereafter *Murphy*); claims 2 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Corder in view of Olsen; claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Colin (U.S. Patent No. 5,110,023) and Murphey; and claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Corder in view of Olsen and Rivera (U.S. Patent No. 6,234,372).

The basic requirements of a *prima facie* case of obviousness under 35 U.S.C. § 103 is outlined in MPEP § 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art and not based on applicant's disclosure.

In view of the above, it must be borne in mind that, in referring to "one of ordinary skill in the art" the field of art to which this passage refers is the field of the application under examination. The present application is directed to a device in the field of power tools such as might be used by landscapers, and to vibration damping in such tools (see, for example, page 1, lines 4-12 and page 2, lines 25-27).

Claim 2 recites that "the second loop further includes means for damping vibrations emanating from the tool." A combination of Olson with Brame to reject claim 2 under 35 U.S.C. § 103 fails to teach or suggest this limitation. First, Brame does not teach or suggest the "means for gripping" of claim 1, and Olson does not provide the missing teaching.

Additionally, Neither Brame nor Olsen teach or suggest a use that includes a power landscaping tool, and thus neither can teach or suggest "means for damping vibrations emanating from the tool." The Examiner suggests that there would be a motivation to combine to make Brame's leash more comfortable, and that, once combined, such padding would also dampen vibrations. However, the standard requires that the combination must *teach or suggest all the claim limitations*. The limitation is directed to means for damping, not to means for making comfortable. Neither reference has anything to say with regard to damping vibrations, and offers no motivation to seek a solution to such a problem. A combination of the references cannot teach more than the sum of the parts. If neither reference teaches or suggests vibration damping, then neither can a combination of the references.

Even if the combination were sufficient to teach or suggest all the limitations of claim 2 (which applicant disputes), a combination is inappropriate. Brame is directed to the field of devices to aid in applying tape, such as for masking during automotive painting operations (see, for example, column 1, lines 7-9 and 23-29), while Olsen is directed to the field of devices used for restraining a patient, such as to a hospital bed, for example (see column 1, lines 6-10 and 68, and column 2, line 1). The references are from different fields of art, and there is no logical connection between these fields that would motivate someone in either field to seek such a combination. More importantly, there is no teaching or suggestion in either of these references that one of ordinary skill in the field related to power tools, landscaping, or vibration damping

would be motivated to look to these references for direction. Without the benefit of impermissible hindsight, there would be no obvious connection between these references.

Finally, Neither reference is analogous prior art. MPEP § 2141.01(a) states that “[i]n order to rely on a reference as a basis for rejection of an applicant's invention [under 35 U.S.C. § 103], the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” Neither Brame nor Olsen are in a field of art that relates to the present invention, and neither is pertinent to the problem with which the applicant was concerned. Accordingly, neither is appropriate for a rejection under 35 U.S.C. § 103.

For the reasons outlined above, claim 2 is allowable over the art of record, apart from its allowability as depending from an allowable base claim.

Claim 6 is rejected over a combination of Brame with Murphy. However, such a combination fails to teach or suggest all the limitations of claim 6. Brame fails to teach or suggest the gripping means of claim 1, and Murphy cannot remedy the deficiency. Further more, the references are neither analogous nor related to each other. Accordingly, there would be no motivation for one of skill in the art to refer to either reference, and there is no motivation in either reference to combine with the other. Accordingly, claim 6 is allowable over Brame and Murphy, individually or combined.

Claim 9 recites that “the second strap comprises a resilient member affixed to an inner surface thereof, configured to dampen vibrations transmitted by the support.” A combination of Corder with Olsen fails to teach or suggest this limitation. Neither reference teaches any structure that is configured to dampen vibrations transmitted by the support. Thus a combination of these references would also fail to teach or suggest the limitation of claim 9. Additionally, these references suffer from the same shortcomings, with respect to their appropriateness under § 103, as the references cited in rejecting claim 2, namely, neither reference is in a field sufficiently related to the field of the present invention as to motivate one of ordinary skill to consider the teachings thereof; and, even if one of ordinary skill were somehow directed to one of the references, there is nothing in either of the references that would lead someone to the other reference, or motivate a combination therewith.

Clearly, claim 9 is allowable over the art of record, apart from its allowability as depending from an allowable base claim.

Claims 11 and 12 are rejected over a combination of Corder with Colin and Murphy. However, Corder does not teach or suggest each limitation of claim 7, from which claims 11 and 12 depend, and neither Colin nor Murphy can remedy the deficiency, since none of the three references teaches or suggests a strap adjustable to affix to a user's wrist. Additionally, none of the three references is analogous art (see MPEP § 2141.01(a)), and thus cannot properly be cited in a rejection under § 103.

Claim 13 recites "an elastomeric gripping surface affixed to a side of the first strap such that when the strap is formed into the first loop, the elastomeric gripping surface is on an inner surface thereof." The Examiner has argued that it would have been obvious "to include an extra rubber layer in a loop of Corder, Jr., as taught by Depot and Rivera, in order to protect the finish of the tool being carried and to better grip the tool in the support. However, such a combination is logical only by using the claim as a template, which is impermissible hindsight.

The modification proposed by the Examiner would change Corder's principle of operation, and would render it unsatisfactory for its intended purpose. Corder's operation has no relation to carrying a tool, protecting the finish of a tool, or gripping a tool. A combination with Depot or Rivera would vastly alter Corder's principle of operation. Additionally, modifying Corder to securely hold an object (specifically, a bicycle) safely and securely, as taught by Depot and Rivera would render the resulting product unsatisfactory for use as a golf training device. Such a combination is inappropriate (see MPEP§ 2141.01 V & VI).

Finally, the motivation to combine references must come from the references themselves, not from the claim under examination. Corder is directed to a training device for a golfer, and provides no teaching or suggestion to employ its device for holding a tool, and thus offers no motivation to combine. Without such a motivation, the combination is inappropriate (see MPEP§ 2141.01 I & III)

Conclusion

Overall, the cited references do not singly, or in any motivated combination, teach or suggest the claimed features of the embodiments recited in independent claims 1 and 7, and

thus such claims are allowable. Because the remaining claims depend from the allowable independent claims, and also because they include additional limitations, such claims are likewise allowable. If the undersigned representative has overlooked a relevant teaching in any of the references, the Examiner is requested to point out specifically where such teaching may be found.

In light of the above amendments and remarks, Applicants respectfully submit that all pending claims are allowable. Applicants, therefore, respectfully request that the Examiner reconsider this application and timely allow all pending claims. Examiner is encouraged to contact Mr. Bennett by telephone at (206) 694-4848 to discuss the above and any other distinctions between the claims and the applied references, if desired. If the Examiner notes any informalities in the claims, he is encouraged to contact Mr. Bennett by telephone to expeditiously correct such informalities.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC

A handwritten signature in black ink, appearing to read "Harold H. Bennett II", is written over a horizontal line.

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